

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Pilon et al.
Serial No. : 10/045,534
Filed : October 24, 2001
For : ***METHODS AND COMPOSITIONS FOR THE TREATMENT OF
FIBROTIC CONDITIONS & IMPAIRED LUNG FUNCTION & TO
ENHANCE LYMPHOCYTE PRODUCTION***
Examiner : Rachel B. Kapust
Group Art Unit : 1647

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 18, 2004.

Signature: 

Henry J. Cittone

RESPONSE TO FEBRUARY 19, 2004 RESTRICTION REQUIREMENT

This Response is submitted in response to the Restriction Requirement issued on February 19, 2004 in connection with the above-identified application. The deadline for response to the February 19, 2004 Restriction requirement is March 19, 2004. A petition for a 5-month extension of time is being filed concurrently, thus the deadline for response is August 19, 2004. Accordingly, this Response is being timely submitted.

In response to the Official Action mailed February 19, 2004, Applicants hereby elect, with traverse, for further prosecution in this application that invention identified in the Official Action as Group I, Claims 1-36. This restriction requirement is respectfully traversed.

In the February 19, 2004 Restriction Requirement, the Examiner stated that restriction to one of the following inventions is required under 35 U.S.C. § 121:

- | | |
|----------|------------------------------------------------------------------------------------------------------------------------------------------------------|
| Group I | Claims 1-36, drawn to a method of identifying compounds capable of inhibiting fibronectin-mediated processes, classified in class 435, subclass 7.1. |
| Group II | Claims 37-39, drawn to a method of identifying receptor-ligand pairs, classified in class 436, subclass 501. |

It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn. Applicants maintain that a search of the prior art when examining claims 1-36 and should reveal any prior art for the remaining claims, i.e., 37-39.

Applicants note that MPEP § 803 states that if the search of an entire application can be made without serious burden, then the Examiner must examine it on the merits, even if it, as Examiner contends, includes claims to independent or distinct inventions.

Applicants submit that even if Groups I and II represent distinct inventions, a search of the subject matter of each group would not be a serious burden on the Examiner. Applicants note that MPEP § 808.02 states that even if related inventions are shown to be distinct, the Examiner must also show serious burden "by appropriate explanation."

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for these claims being unnecessarily shortened.

Furthermore, it is likely that the same Examiner would be in charge of the divisional application; but since that divisional application will be examined at a much later date, the Examiner will have to conduct a duplicate, redundant search at the time she examines the divisional application. Alternatively, if a different Examiner is assigned to the divisional

application, a significant loss of PTO efficiency would be incurred as a result of the examination of that divisional case.

In view of the foregoing, withdrawal of the requirement for restriction is respectfully requested.

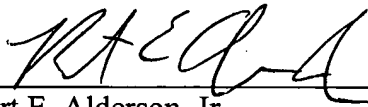
If a telephone interview would be of assistance in the prosecution of this application, Applicants' undersigned attorney invites the Examiner to telephone him at her convenience at the number provided below.

No fee, other than the fee for a petition for five-months extension, is believed to be necessary in connection with the filing of this Amendment. However, if any additional fee is required, the Commissioner is hereby authorized to charge such fee(s) to Deposit Account No. 50-0540.

Early and favorable examination on the merits is respectfully requested.

Respectfully submitted,

Dated: August 18, 2004

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